

#### The Office Action

The Examiner withdrew the previously indicated allowability of claims 2, 5, 6, and 11, and rejected claims 1, 2, 5-7, and 9-11 under 35 U.S.C. § 102 or 35 U.S.C. § 103 as being anticipated by or obvious over Zuckerman, already of record and discussed in prior Amendments. The rejections proffered different and inconsistent interpretations and applications of the Zuckerman reference to the claims.

Claims 8 and 12 were indicated as containing allowable subject matter.

#### The References of Record

Zuckerman discloses a head protective helmet and communication system. The helmet includes a rigid shell 20, 41 (FIGURES 2, 3, and 24). As clearly illustrated in FIGURE 2, the shell 41 terminates above the user's ears. The one of the user's ears, of course, is covered by the ear cup 56 which hangs below the shell. The shell has no zones which cover the user's ears. In FIGURE 24, the user's ears are not shown, but the same shell structure 41 is shown as in FIGURES 1 and 2. Thus, in the embodiment of FIGURE 24, the user's ears are well below and not covered by any zone of the shell.

In the embodiment of FIGURES 2-5, the ear cup 56 is clamped onto the helmet by a generally circular mounting member 48 (FIGURES 5 and 24). The ear cup is connected with a hinge or pivot including a hinge pin 63 about which the ear cup pivots. A torsion spring 64 biases the ear cup to pivot about the hinge pin 63. Hinge pin 63 is illustrated as being a separate and different element from the bracket 61 or the outer shell 57 of the ear cup. As stated in column 6, lines 44-45, the outer shell 57 of the ear cup encircles the hinge pin 63.

In the embodiment of FIGURE 24, the construction 300, which the Examiner at times calls the case of the acoustic device (indeed FIGURE 23 does show that

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construction 300 does function as the case for the loud speaker 55c), has an upward extending tab portion 302 which is wedged underneath the resilient circular mounting member 48 as shown in FIGURES 3 and 24 (column 18, lines 26-36). It will be noted that the self-same mounting is used for both the ear cup 56 and the shroud 300. In the embodiment of FIGURE 24, only the speaker is encased in construction 300. The microphone 54A is dependent below this structure by a conductor 138.

The Claims Distinguish Patentably  
and Unobviously Over the References of Record

First, claim 1 calls for an external shell of rigid material including *two lateral wall portions which cover zones occupied by the ears of a user*. In Zuckerman, the principle shell 41 does not cover the zones occupied by the ears of the user.

Second, claim 1 calls for the case of the acoustical pick-up and speaker combination to be positioned *inside of the principle shell*. The case 57 of the ear cup of Zuckerman is not positioned inside the principle shell. Rather, it hangs down below the principle shell. Claim 1 also calls for the case to include both an acoustic pick-up and a speaker. Shroud 300 only houses a speaker.

Third, claim 1 calls for a removable connection between the case and the external principle shell. In Zuckerman, the ear cup is connected by the hinge and hinge pin 63 to a bracket 61 which, in turn, is connected by the circular spring 48 to a groove in the shock-absorbing foam 46 which is disposed below the exterior shell. Similarly, in the embodiment of FIGURE 24, the shroud 30 is connected by the circular spring 48 with a peripheral band 47 of the internal impact cap 42.

Because at least these three claim limitations are not shown by either the FIGURE 2 nor the FIGURE 24 embodiments of Zuckerman, it is submitted that claim 1

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distinguishes patentably and unobviously over the references of record.

First, claim 2 calls for the acoustic device case to include an extension that defines a connection tab which is configured for receipt into a lateral guide of complementary shape. The hinge pin 63 of Zuckerman is neither an extension of the case nor is it a connection tab.

Second, claim 2 calls for an external principle shell that includes two lateral wall portions covering zones occupied by the user's ears. The shell 41 of Zuckerman, as clearly illustrated in FIGURE 2, terminates well-above the zones occupied by the user's ear. The external principle shell of Zuckerman does not include two ear covering zones.

Third, claim 2 calls for a lateral guide carried by at least one of the lateral wall portions. The external shell 41 of Zuckerman neither covers the user's ears nor defines a lateral guide.

Fourth, claim 2 calls for the connection tab of the case to be received in the lateral guide. Zuckerman does not disclose or fairly suggest a tab and guide interconnection means. Moreover, Zuckerman teaches that any interconnection should be between the ear cup or shroud and the internal impact absorbing elements.

Fifth, claim 2 calls for the connection means to attach and position the acoustic pick-up and speaker case *inside* one of the lateral wall portions that cover the ears. The acoustic assembly of Zuckerman is not mounted inside the external principle shell. In FIGURE 2, it hangs below it. In FIGURE 24, the speaker and the shroud are disposed below, not inside of, the principle shell 41.

Accordingly, it is submitted that claim 2 and claims 5-6 dependent therefrom distinguish patentably and unobviously over the references of record.

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First, claim 7 calls for a rigid external principle shell which has *integral lateral rigid wall portions which cover ears of an associated user*. As most clearly shown in FIGURE 2, the shell 41 of Zuckerman terminates well above the user's ears. It does not cover them.

Second, claim 7 calls for a case attached *inside of the rigid principle shell within one of the ear zones*. In Zuckerman, the ear cup 56 is not disposed inside the rigid shell, much less inside an ear covering zone of the principle shell. Similarly, flange 300 is not mounted inside the shell 41. Rather, it is disposed below it.

Third, claim 7 calls for a speaker and an acoustic pick-up disposed *inside the case within the ear zone*. Again, claim 7 defines the ear zones as the integral lateral rigid wall portions of the rigid shell (lines 5-6). In FIGURE 2 of Zuckerman, the speaker and the acoustic pick-up are both disposed below the rigid shell 41. In the embodiment of FIGURE 24 of Zuckerman, the acoustic pick-up extends down below the shroud 300 and is not disposed near the user's ears.

Fourth, claim 7 calls for the case to be *detachably* attached to the principle shell. It is submitted that once the ear cup 56 or the shroud 300 is mounted underneath the circular spring 48 (note also FIGURE 25), they will remain firmly attached unless the helmet is at least partially disassembled. Zuckerman does not teach or fairly suggest an acoustic case which is readily and quickly removed and replaced, even during an emergency situation, if the batteries should die or the unit should otherwise malfunction.

Accordingly, it is submitted that claim 7 and dependent claims 9 and 10 distinguish patentably and unobviously over the references of record.

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Further, dependent claim 9 calls for the case to have two slots, one for receiving the acoustic pick-up and a second for receiving the speaker. Zuckerman fails to disclose this construction.

Further, dependent claim 10 calls for the acoustic pick-up to be located above the speaker. In FIGURE 2 of Zuckerman, the acoustic pick-up 54 is clearly located below the speaker 55. Similarly, in the embodiment of FIGURE 24, the acoustic pick-up 54A is located well below the speaker 55C.

Accordingly, it is submitted that dependent claims 9 and 10 distinguish patentably over the references of record.

First, claim 11 calls for at least one tab receiving guide and for the case to have a tab which is selectively engageable with the guide for removably mounting the case to the shell adjacent the ear-receiving areas. Zuckerman discloses no such tab and guide arrangement. Hinge pin 63 is not a tab. There is no guide mounted to the interior of the shell for receiving the upward projecting portion or tab 302 of FIGURE 21. Moreover, the upward projection portion or tab 302 is not selectively engageable nor is it removably mounted.

Second, claim 11 calls for the shell to define ear-receiving areas. Again, the shell 41 in all embodiments of Zuckerman terminates well above the ears and defines no ear-receiving area.

Accordingly, it is submitted that claim 11 and claim 12 dependent therefrom distinguish patentably over the references of record.

**MPEP § 706.04**

As pointed out by the MPEP, "great care should be exercised in authorizing such a rejection [of previously allowed claims]".

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This section further states:

Because it is unusual to reject a previously allowed claim, the Examiner should point out in his/her Office Action that the claim now being rejected was previously allowed using Form Paragraph 7.50

¶ 7.50 *Claims Previously Allowed, Now Rejected, New Art*

The indicated allowability of claim [1] is withdrawn in view of the newly discovered reference(s) to [2]. Rejection(s) based on the newly cited reference(s) follow.

**Examiner Note:**

1. In bracket 2, insert the name(s) of the newly discovered references.

It is submitted that the withdrawal of allowance and rejection of claims over a reference already of record, particularly a reference which fails to disclose numerous elements of every claim, as outlined above, is procedurally improper and inappropriate.

MPEP § 706.04 emphasizes that "an Examiner should not take an entirely new approach or attempt to reorient the point of view of a previous Examiner". It is submitted that this same admonition should apply to actions previously taken by the same Examiner. In the November 28, 2001 rejection, the Examiner changes and reorients his point of view even within the Office Action. The Zuckerman reference is applied contradictorily and inconsistently even within the rejection, and inconsistently with the interpretation given to the claims and the reference in the earlier Office Actions.

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MPEP § 1308.01

Although MPEP § 1308.01 focuses on withdrawal of applications from issue, most of the discussion is equally applicable to any allowed claim. Again, § 1308.01 emphasizes withdrawal of allowability *when a new reference(s) is discovered*. It is submitted that wavering by the Examiner and the alternate allowance and rejection of claims over references of record is highly irregular and improper. It is a poor reflection on the decision making capability and judgment of the U.S. Patent Office.

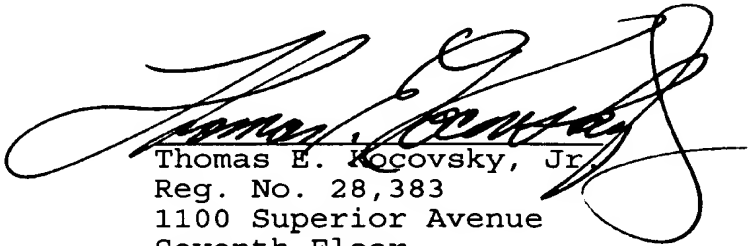
It is again requested that the Examiner reinstate his earlier and proper allowance of claims whose allowance was withdrawn.

CONCLUSION

For the reasons set forth above, it is submitted that claims 1, 2, and 5-12 distinguish patentably and unobviously over the references of record. An early allowance of all claims is requested.

Respectfully submitted,

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CERTIFICATE OF MAILING

I hereby certify that this **AMENDMENT D (W/APPENDIX 1)** in connection with U.S. Patent Application Serial No. 09/101,601 is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C., 20231, on this 29<sup>th</sup> day of April, 2002.

By: Hilary McNulty

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